

In the present situation, the Examiner has clearly instituted a new rejection based on prior art **not** of record, namely Behr '789 and Sato '403 in order to support the rejection of claims 49-52 under 35 U.S.C. §103(a). Under M.P.E.P. 707.07(f), the Examiner cannot introduce a new prior art **not** of record and make the Office Action final.

Secondly and more importantly, there are two criteria for a proper requirement for restriction between patentably distinct inventions as set forth in M.P.E.P. §803:

- (1) the inventions must be independent (see M.P.E.P. §§802.01, 806.04, 808.01) or distinct as claimed (see M.P.E.P. §§806.05-806.05(i)); and
- (2) there must be a serious burden on the examiner if restriction is not required (see M.P.E.P. §§803.02, 806.04(a)-(j), 808.01(a) and 808.02).

Independent means that there is no disclosed relationship between elected claims 49-52 and claims 53-59 the alleged non-elected invention, that is, elected claims 49-52 and alleged non-elected claims 53-59 are unconnected in design, operation, or effect under the disclosure (see M.P.E.P. §808.01). Distinct means that elected claims 49-52 and alleged non-elected claims 53-59 are related as combination and subcombination as alleged by the Examiner, but are capable of separate manufacture, use, or sale as claimed, and ARE PATENTABLE OVER EACH OTHER.

In order to establish that combination and subcombination inventions as presented herein as combination, non-elected claims 7-13 and subcombination, elected claims 1-6 and 14-18, two-way distinctness must be demonstrated in addition to reasons for insisting on restriction are necessary (i.e., separate classification, status, or field of search, see M.P.E.P. §808.02) as required under M.P.E.P. §806.05(c). The Examiner must show that (1) the combination does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness);

and (2) the subcombination can be shown to have utility either by itself or in other and different relations.

In the present situation, the Examiner has **not** provided any reasons as to why claims 49-52 of the elected invention and newly added claims 53-59 of the alleged non-elected invention are **independent**, i.e., are not connected in design, operations, or effect under the disclosure, or **distinct**, i.e., are PATENTABLE over each other as required by the M.P.E.P..

As clearly shown in FIGs. 1-2 of the present invention, all pending claims, including elected claims 49-52 and alleged non-elected claims 53-59 are directed all those components shown therein, for example, an information display equipment 1, including a map display (display unit 11), a map storage device (map memory 12), a retrieval condition setting means (i.e., arithmetic processing department 10, see FIGs. 4-6 in combination with wheel speed sensor 16 - GPS receiver 19), a communication equipment (display side communications equipment 21), and an icon display means (see FIGs. 8-13).

Under M.P.E.P. §806.03,

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, **restriction therebetween should NEVER be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

The instant application discloses and claims but a single information display equipment 1, shown in FIG. 1, having a map display (display unit 11), a map storage device (map memory 12), a retrieval condition setting means (i.e., arithmetic processing department 10, see FIGs. 4-6 in combination with wheel speed sensor 16 - GPS receiver 19), a communication equipment (display side communications equipment 21), and an icon display means (see FIGs. 8-13) a host processor,

which includes therein all internal elements shown in FIG. 2. The claims in both the elected group and the alleged non-elected group as identified by the Examiner define the same essential characteristics of that embodiment. Only the breadth and scope with which the respective elements are defined is varied, and therefor restriction between claims 49-52 (Group I) and newly added claims 53-59 should not have been required under the current rules of restriction practice.

Moreover, elected claims 49-52 and non-elected claims 53-59 are NOT distinct since they are NOT patentable over each other. For example, if the details of the component, i.e., map storage device and map display etc., are NOT in the newly added claims 53-59, these claims would NOT be independently patentable.

Therefore, as demonstrated above, all claim inventions are clearly connected in design and operations, and are **not** independent and distinct from one another as alleged by the Examiner.

Furthermore, under M.P.E.P §806.05 and §808.02, even assuming *arguendo* that the related inventions as claimed are shown to be distinct, the Examiner must still show by appropriate explanation one of the following: (1) separate classification thereof; (2) separate status in the art when they are classifiable together; (3) a different field of search.

In the present situation, the Examiner has either not nor simply and arbitrarily provided different subclasses for the elected claims 49-52 and the alleged non-elected claims 53-59. However, a review of the record reveals that all claims of the non-elected inventions share similar scope as that recited in the elected invention as defined, for example, in independent claims 49 and 52. A search of the many apparatus and method claims of the non-elected inventions would necessarily include a search of the apparatus and method claims 49 and 50 as defined. M.P.E.P. §803 states, in part:

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

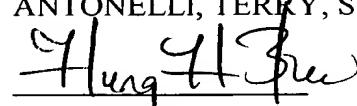
In the present situation, there is no undue burden on the Examiner to search and examine the entire application.

In view of the foregoing reasons, Applicants respectfully submit that the Examiner has not satisfied the criteria for a restriction requirement under M.P.E.P. §803, nor has the Examiner demonstrated any serious burden for a search and a complete examination of all claims on the merits. Therefore, Applicants respectfully request that claims 53-59 be reinstated for examination.

CONCLUSION

In view of the foregoing facts and explanations, Applicants respectfully request the Commissioner to (1) withdraw the designation of Paper No. 29 mailed on March 5, 2002 as a "final" Office action; (2) reissue another Office Action as required by M.P.E.P. 707.07(f) be issued, and that the period for response be restarted; (3) withdraw the Requirement for Restriction of constructively elected claims 49-52 and allegedly non-elected claims 53-59; (4) return the application for examination of all claims on the merits; and (5) grant such other and further relief as justice may require.

To the extent necessary, the applicants petition for an extension of time under 37 C.F.R. §1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (503.35636PX1).

Respectfully submitted,
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HHB
June 4, 2002